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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,872	08/27/2001	Jean Ackermann	20757	4842
151	7590	10/15/2003	EXAMINER	
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110			AULAKH, CHARANJIT	
		ART UNIT	PAPER NUMBER	
		1625	DATE MAILED: 10/15/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/939,872</b>	Applicant(s) <b>Ackermann, J. et al.</b>
	Examiner <b>CHARANJIT AULAKH</b>	Art Unit <b>1625</b>
		
<i>— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —</i>		
<b>Period for Reply</b>		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
- Extensions of time may be available under the provisions of 37 CFR 1.138 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).		
<b>Status</b>		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Aug. 6, 2003</u>		
2a) <input checked="" type="checkbox"/> This action is FINAL.      2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
<b>Disposition of Claims</b>		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-58 and 60-74</u> is/are pending in the application.		
4a) Of the above, claim(s) <u>9, 28-41, and 64-66</u> is/are withdrawn from consideration.		
5) <input checked="" type="checkbox"/> Claim(s) <u>47, 49, 51, 53-55, 58, 61, 68, and 71</u> is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1-3, 6, 8, 10-12, 14-16, 19-27, 42-44, 52, 73, and 74</u> is/are rejected.		
7) <input checked="" type="checkbox"/> Claim(s) <u>4, 5, 7, 13, 17, 18, 45, 46, 48, 50, 56, 57, 60, 62, 63, 67, 69, 70, and 71</u> is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
<b>Application Papers</b>		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
<b>Priority under 35 U.S.C. §§ 119 and 120</b>		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). *See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
<b>Attachment(s)</b>		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
6) <input type="checkbox"/> Other: _____		

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### **DETAILED ACTION**

1. According to paper no. 16 filed on Aug. 6, 2003, the applicants have canceled claim 75 and furthermore, have amended claims 47, 49, 51, 53-56, 58, 61, 68 and 71.
2. Claims 1-58 and 60-74 are now pending in the application. Claims 9, 28-41 and 64-66 remain withdrawn as being directed to non-elected inventions.

#### *Response to Arguments*

3. Applicant's arguments filed on Aug. 6, 2003 ( paper no. 16 ) have been fully considered but they are not persuasive regarding obviousness rejections of claims 1-3, 6, 8, 10-12, 14-16, 19-27, 42-44, 73 and 74 as well as objections due to Improper Markush Group. The examiner agrees with the applicants arguments regarding definiteness and enablement of the term ---esters ---. The examiner also agrees with the applicants arguments that the instant compounds where V is other than O and either W or X is SO<sub>2</sub>NR<sub>1</sub>, are not homologs and therefore, will not be obvious. Regarding Improper Markush Group, the restriction was made final as stated in the last office action. Furthermore, the applicants admit that variable X and W are critical for the common core ( see page 17, first paragraph ) of the instant compounds. Therefore, the applicants should either amend the claims to delete non-elected subject matter or petition the restriction requirement. In regard to obviousness rejection, the rejection is being maintained now only for those claims where V is O, n is 0, m is 3-4 and W or X represents SO<sub>2</sub> in the instant claims.

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NEW GROUNDS OF REJECTION

*Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 52, variable A15 is defined as phenyl substituted with at least one. However, this substituent is not defined.

*Allowable Subject Matter*

6. Claims 4, 5, 7, 13, 17, 18, 45, 46, 48, 50, 56, 57, 60, 62, 63, 67, 69, 70 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 47, 49, 51, 53-55, 58, 61, 68 and 71 are allowed.

*Conclusion*

8. Rejections under 35 U.S.C. 112, first paragraph and second paragraph are now withdrawn.

9. Rejection of claims 1-3, 6, 8, 10-12, 14-16, 19-27, 42-44, 73 and 74 under 35 U.S.C. 103(a) is maintained for the reasons of record.

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10. Objection of claims 1-7, 10-27, 60, 62, 63, 73 and 74 due to Improper Markush Group is maintained for the reasons of record.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chana Aulakh whose telephone number is (703) 305-4482. The examiner can normally be reached on "Monday-Thursday" from 7:30 A.M. to 6:00 P.M. If the attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Alan Rotman, can be reached on (703) 308-4698. The fax number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's receptionist whose telephone number is (703) 308-1235.

*C. S. Aulakh*  
CHARANJIT S. AULAKH

PRIMARY EXAMINER